

**REMARKS**

Upon entry of the Amendment, claims 1-21 are pending in the application. Claim 6 has been amended. Support for claim 6 can be found in the specification, such as on page 26 of the specification. Therefore, no new matter has been added.

**I. Claim Rejections - 35 U.S.C. § 112**

Claim 6 is rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

The Examiner asserts that there is improper antecedent basis for the term “binder” in claim 6. Claim 6 has been amended to give proper antecedent basis for the term “binder.”

**II. Claim Rejections - 35 U.S.C. § 103**

The Examiner has set out seven (7) rejections as follows:

Claims 1, 10, 12, 20 and 21 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Published Application No. 2001/0015279 to Marutsuka (“Marutsuka ‘279”) in view of U.S. Patent No. 4,927,897 to Kawata *et al.* (“Kawata ‘897”).

Claims 2 and 3 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Marutsuka ‘279 in view of Kawata ‘897, as applied to claim 1, and further in view of U.S. Patent No. 4,387,154 to Whitmore;

Claims 4, 5 and 7 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Marutsuka ‘279 in view of Kawata ‘897 and Whitmore ‘154 as applied to claim 2, and further in view of U.S. Patent No. 4,160,669 to Habu *et al.*;

Claims 6 and 8 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Marutsuka ‘279 in view of Kawata ‘897 as

applied to claim 1, and further in view of U.S. Patent No. 3,989,522 to Poot *et al.*;

Claim 9 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Marutsuka '279 in view of Kawata '897 as applied to claim 1, and further in view of U.S. Patent No. 4,362,796 to Monroe;

Claim 11 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Marutsuka '279 in view of Kawata '897 as applied to claim 1, and further in view of U.S. Patent No. 4,631,214 to Hasegawa; and

Claim 13 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Marutsuka '279 in view of Kawata '897 as applied to claim 1, and further in view of U.S. Patent No. 7,060,241 to Glatkowski.

In this regard, each of the above rejections is based on Marutsuka '279 in view of Kawata '897.

Applicants respectfully traverse.

Marutsuka '279 teaches producing an electromagnetic radiation shield. The method disclosed in Marutsuka '279 entails forming a coating, optionally subjecting the coating to reduction treatment, and forming an electroless plating layer on the coating. Referring to page 3 of the Office Action, the Examiner concedes that Marutsuka '279 is deficient in that it fails to teach exposing and developing a silver salt-containing layer to form a metal silver portion and a light transmitting portion. The Examiner looks to Kawata '897 to alleviate this deficiency in Marutsuka '279. Kawata '897 teaches exposing a metal complex of Group VIII or IB with UV light so as to polymerize the complex and provide a metal that can function as a catalyst for non-electrode plating. *See*, col. 11, lines 27-46.

Applicants respectfully submit that Kawata '897 fails to alleviate the deficiencies of Marutsuka '279. As with Marutsuka '279, Kawata '897 also fails to teach developing a silver salt-containing layer. The exposure disclosed in Kawata '894 does not provide for developing a silver salt-containing layer. For example, both Marutsuka '279 and Kawata '894 fail to teach or suggest forming a metal silver portion (e.g., a patterned metal silver portion) and a light-transmitting portion at the same time. Kawata '894 also teaches utilizing the UV light exposure in order to proceed with a polymerization reaction. Silver metal is produced in the course of the polymerization reaction. This differs from the production of a developed silver with exposure and development. Kawata '894 does not mention or suggest that the UV light exposure is performed in order to form a developed silver. Kawata '894 does not mention or suggest the way to produce an electromagnetic wave-shielding film having a conductive material portion and a light-transmitting portion. In this regard, Kawata '894 fails to alleviate the deficiencies of Marutsuka '894.

Further, a person of ordinary skill in the art would not have been motivated to add a development step to the method disclosed in Kawata '894 or Marutsuka '279. Kawata '894 fails to teach a development step after an exposure step. In this regard, Kawata '894 teaches that the unexposed portion thereof still contains silver halide ( $\text{Ag}^+$ ). Where a person of ordinary skill in the art would treat the unexposed portion disclosed in Kawata '894 with the plating solution disclosed in Marutsuka '279, the  $\text{Ag}^+$  turns into a silver metal. As Marutsuka '279 teaches a plating solution containing formalin, the plating solution disclosed in Marutsuka '279 contains a reducing agent. Since the exposed portion and the unexposed portion are both plated, the

exposure disclosed in Kawata '894 would provide a non-patterned membrane having no light-transmitting portion. In this regard, Marutsuka '279 and Kawata '894 fails to motivate a person of ordinary skill in the art to add the development step to the method disclosed in Kawata '894 or Marutsuka '279.

### **III. Double Patenting**

Claims 1, 13 and 20 are provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-6 of co-pending Application No. 11/159,218.

Applicants defer responding at this time to this provisional obviousness-type double patenting rejection, pursuant to MPEP § 804(I)(B).

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111  
Appln. No.: 10/743,437

Docket No: Q78963

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


Respectfully submitted,

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